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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,827	03/15/2004	Tsu-Hsing Chen	251209-1240	1384
24504 7590 08/22/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			EXAMINER HEYI, HENOK G	
			ART UNIT 2627	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800,827

Applicant(s)

CHEN ET AL.

Examiner

Kezhen Shen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being unpatentable by Chen et al. US 2004/0088440 A1 for the same reason as stated in the last Office Action (grounds and rejection are restated for applicant's convince).

Regarding claim 1 Chen et al. teaches a disc player (10 of Fig. 1, [0019] optical disc drive), comprising of an optical drive (14 of Fig. 1, [0019] read/write drive) for reading data from a disc, a card reader (16 of Fig.1, [0019] multi-format card read/write controller) for reading image files from a card and a micro-controller (12 of Fig. 1, [0019] micro-controller) connected to said optical drive and said card reader for receiving data or image files from said optical drive or said card reader (Fig. 1, [0019] The micro-controller for controlling and processing actions and signal communications between each component.), wherein when said micro-controller is operated in a soundless operation mode, said optical drive is activated to output an audio data and said micro-controller may transfer the audio data to audio signals for playing (Fig. 2, [0022] The read/write drive starts to read data in DVD. Next it transfers the media data to the media

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data codec for decompression. Afterwards, the analog interface transducer receives the decompressed data that converts the digital data into analog media signals. This is finally received by the television to be played).

Regarding claim 2 Chen et al. teaches the disc player as claimed in claim 1, wherein said audio data is a CD-DA format data or a MP3 file ([0019] read/write drive can read/write of the optical disc of the formats like CD-R, CD and MP3).

Regarding claim 3 Chen et al. teaches the disc player as claimed in claim 1, wherein said card is selected from a SD card, a MMC card, a SM card, a CF card, and a MS card ([0019] The memory card include secured digital (SD), multimedia card (MMC), smart media (SM), memory stick (MS), compact flash (CF) formats).

Regarding claim 4 Chen et al. teaches the disc player as claimed in claim 1, wherein said optical drive is a DVD optical drive or a CD optical drive ([0019] read/write drive can read/write of the optical disc of the formats like DVD and CD).

Regarding claim 5 Chen et al. teaches the disc player as claimed in claim 1, wherein said soundless operation mode includes showing or editing said image files on a TV screen (Fig. 4, [0020] The media digital data can be played using a television).

Regarding claim 6 Chen et al. teaches a disc player (10 of Fig. 1, [0019] optical disc drive), comprising: at least one optical drive (14 of Fig. 1, [0019] read/write drive) for reading data from a disc; a card reader (16 of Fig.1, [0019] multi-format card read/write controller) for reading data from a card; and a micro-controller (12 of Fig. 1, [0019] micro-controller) connected to said at least one optical drive and said card reader for receiving data from said at least one optical drive or said card reader (Fig. 1, [0019]

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The micro-controller for controlling and processing actions and signal communications between each component.), wherein when said micro-controller is operated in a soundless operation mode, if one of said at least one optical drive and said card reader may provide an audio data to said micro-controller, said micro-controller transfer said audio data to audio signals for playing (Fig. 2, [0022] The read/write drive starts to read data in DVD. Next it transfers the media data to the media data codec for decompression. Afterwards, the analog interface transducer receives the decompressed data that converts the digital data into analog media signals. This is finally received by the television to be played).

Regarding claim 7 Chen et al. teaches the disc player as claimed in claim 6, wherein said audio data is a CD-DA format data or a MP3 file ([0019] read/write drive can read/write of the optical disc of the formats like CD-R, CD and MP3).

Regarding claim 8 Chen et al. teaches the disc player as claimed in claim 6, wherein said card is selected from a SD card, a MMC card, a SM card, a CF card, and a MS card ([0019] The memory card include secured digital (SD), multimedia card (MMC), smart media (SM), memory stick (MS), compact flash (CF) formats).

Regarding claim 9 Chen et al. teaches the disc player as claimed in claim 6, wherein said at least one optical drive is a DVD optical drive, a CD optical drive, a DVD recordable optical drive, or a CD recordable optical drive ([0019] read/write drive can read/write of the optical disc of the formats like DVD, DVD+R/RW, DVDR/RW, CD-R and CD).

Regarding claim 10 Chen et al. teaches the disc player as claimed in claim 6, wherein said soundless operation mode includes showing or editing data stored in said card on a TV screen (Fig. 4, [0020] The media digital data can be played using a television).

Regarding claim 11 Chen et al. teaches the disc player as claimed in claim 6, wherein said soundless operation mode includes copying data from said card reader to said at least one optical drive (Fig. 6, [0026] Mutual data transmission is possible between various kinds of memory devices including the memory card and optical disc).

Regarding claim 12 Chen et al. teaches a method of controlling a disc player used in a soundless operation mode, comprising the steps of activating a plurality of hardware (14 and 16 of Fig. 1, [0019] read/write drive and multi-format card read/write controller) for providing at least one audio data ([0020] media data) and if one of said hardware being capable of providing said at least one audio data, transferring said audio data to audio signals for playing (Fig.4, [0022] The multi-format card read/write controller starts to read data in the memory card and transfers the read media data to the media data codec for decoding and analog interface transducer for conversion from digital data to analog signal. The data then can be played through a television).

Regarding claim 13 Chen et al. teaches the method as claimed in claim 12, wherein said hardware includes at least one optical and a card reader (14 and 16 of Fig. 1, [0019] read/write drive and multi-format card read/write controller).

Regarding claim 14 Chen et al. teaches the method as claimed in claim 13, wherein said card reader is capable of reading card selected from a SD card, a MMC card, a SM

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card, a CF card, and a MS card ([0019] The memory card include secured digital (SD), multimedia card (MMC), smart media (SM), memory stick (MS), compact flash (CF) formats).

Regarding claim 15 Chen et al. teaches the method as claimed in claim 13, wherein said at least one optical drive is a DVD optical drive, a CD optical drive, a DVD recordable optical drive, or a CD recordable optical drive ([0019] read/write drive can read/write of the optical disc of the formats like DVD, DVD+R/RW, DVDR/RW, CD-R and CD).

Regarding claim 16 Chen et al. teaches the method as claimed in claim 12, wherein said audio data includes a MP3 file or a CD-DA music format data ([0019] read/write drive can read/write of the optical disc of the formats like CD-R, CD and MP3).

Response to Arguments

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "at the same time that is transfers audio signals from the optical drive", "one for outputting a video signal and one for outputting an audio signal, at the same time") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regard to the remarks, the applicant argues "claim 1 defines that the micro-controller is operated in a soundless operation mode, during which the micro-controller

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receives data or image files from the optical drive or card reader at the same time that it transfers audio signals from the optical drive”, however the condition of transferring data at the same time it transfers audio signals is not claimed. Also the **soundless operation mode** is defined in claim 12 by, activating a plurality of hardware for providing at least one audio data; and if one of said hardware being capable of providing said at least one audio data, transferring said audio data to audio signals for play. The claimed steps **does not limit soundless operation mode to only video signals** and it appears the soundless operation mode contradicts what is being argued due to audio data being transferred instead of video or image data.

Examiner's Note

The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, “the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does

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not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kezhen Shen whose telephone number is (571) 270-1815. The examiner can normally be reached on Monday - Friday 7:30 am to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kezhen Shen/

SUPERVISORY PATENT EXAMINER

VU LE